

REMARKS

Claims 1-18 are pending in the above identified application. In the Final Office Action, the Examiner maintains the rejection of claims 1-18. Applicant has amended claims 1 and 11 to clarify the claims in response to the Examiner's comments in the Final Office Action. Support for these amendments may be found in the specification, for example at page 2, lines 16-18, and at page 6, lines 20-24. No new matter is added by these amendments.

Claim Rejections Under 35 U.S.C. § 103

The Examiner has rejected Claims 1-18 "under 35 U.S.C. 103(a) as being unpatentable over Harshberger et al. in view of Bolton et al." (Final Office Action, p. 2).

- I. *The Combination of Harshberger with Bolton does not teach or suggest all of the limitations of claims 1-18, as amended.*

Without acquiescing to the rejection, and solely to expedite prosecution, Applicant has amended claim 1 to recite, in part, "wherein further rotation of said screw forcibly clamps a portion of said panel between said tab and said flange" and claim 11 to recite, in part, "continuing rotation of said screw to forcibly clamp said portion of said panel between said tab and said flange." Neither Harshberger nor Bolton teach "wherein further rotation of said screw forcibly clamps a portion of said panel between said tab and said flange," as is recited in claim 1, or "continuing rotation of said screw to forcibly clamp said portion of said panel between said tab and said flange," as is recited in Claim 11.

Harshberger teaches "[a] computer assembly comprised of a plurality of modular units which are readily connectable by pluggable terminals to permit quick interchangeability and/or

replacement of certain units by untrained and unskilled personnel.” (Harshberger, Abstract). In particular, Harshberger teaches that

[s]witch 172 includes a latch 174 which, when the switch is "on," is in a closed position 176 where it extends through a slot 177 and engages against a keeper 178 fixed against the inside surface of wall 32. In this position full power is supplied to the CPU module 22. When switch 172 is rotated counterclockwise 45 degrees from the "on" position, latch 174 is rotated to a second position 180 where it is still locked against keeper 178 but with the power "off." to [sic] In this way the computer may be turned off and the key removed from switch 172, but latch 174 remains locked against keeper 178 to prevent inadvertent removal of module 22 from bay module 20.

Finally, switch 172 may be turned from its "on" position 90° counterclockwise to an "off" position wherein latch 174 is located at a position 182 in which latch 174 is totally disengaged from keeper 178. In this "off" position there is no power being supplied to the CPU module 22 and module 22 may be moved from module 20 by pulling outwardly on handle 121.

(Harshberger, col. 6, lines 16-35). Therefore, Harshberger teaches a switch that moves a latch through a slot to engage a keeper. Once the latch is in place, the switch of Harshberger cannot be further rotated. Therefore, Harshberger does not teach or suggest “wherein further rotation of said screw forcibly clamps a portion of said panel between said tab and said flange,” as is recited in claim 1, or “continuing rotation of said screw to forcibly clamp said portion of said panel between said tab and said flange,” as is recited in Claim 11.

Bolton does not cure the defects in the teachings of Harshberger. The invention disclosed by Bolton “relates generally to room air conditioners and, more particularly, to a locking device for securing a slide out chassis to a cabinet mounted in a wall opening.” (Bolton, col. 1, lines 7-9). In particular, Bolton teaches that

[m]ounted within the deck U-shaped portion 19, in an L-shaped lock member 23 having a tab 24 which is extendable through a hole 26 in the partition side wall 17 so as to engage a flange

portion 27 of the wrapper 12 to thereby lock the chassis 13 in place and prevent it from being moved inwardly into the room. Near the other end of the lock member 23, a screw 28 is provided to secure the locking member 23 against the front wall 21 of the deck 18. The screw 28 passes through the front wall 21 by way of a slot 29 which allows the screw 28 to horizontally reciprocate with the lock member 23 so as to move between the lock and unlocked positions. Access to the screw 28 is provided by an elongate opening 31 formed in the escutcheon 16 as shown in FIG. 1.

(Bolton, col. 2, lines 50-63). Bolton, then, teaches a sliding latch that is secured by a screw. The screw merely holds the latch in place. As Bolton states, “screw 28 is provided to secure the locking member 23 against the front wall 21 of the deck 18” (Bolton, col. 2, lines 56-58). Therefore, Bolton does not teach or suggest “wherein further rotation of said screw forcibly clamps a portion of said panel between said tab and said flange,” as is recited in claim 1, or “continuing rotation of said screw to forcibly clamp said portion of said panel between said tab and said flange,” as is recited in Claim 11.

Claims 1 and 11 are therefore allowable over Harshberger and Bolton. Claims 2-10 depend from claim 1 and are therefore allowable over Harshberger and Bolton for at least the same reasons as is claim-1. Claims 12-18 depend from claim 11 and are allowable over Harshberger and Bolton for at least the same reasons as is claim 11.

II. There is no motivation to combine the teachings of Harshberger and Bolton in the fashion suggested by the Examiner.

As was discussed in the Amendment filed on December 4, 2002, there is no motivation to combine the teachings of Harshberger and Bolton for many reasons. As discussed above, Harshberger teaches a switch with a latch where “when the switch is ‘on,’ [the latch] is in a closed position 176 where it extends through a slot 177 and engages against a keeper 178 fixed against the inside surface of wall 32.” (Harshberger, col. 6, lines 16-19). Bolton teaches that

“[t]he screw 28 passes through the front wall 21 by way of a slot 29 which allows the screw 28 to horizontally reciprocate with the lock member 23 so as to move between the lock and unlocked positions.” (Bolton, col. 2, lines 56-58). The two functions are quite different. The switch of Harshberger can not be replaced with the screw of Bolton since the latch of Harshberger does not “horizontally reciprocate” as does the latch of Bolton.

Further, the modification of Harshberger with the teachings of Bolton would render Harshberger unsatisfactory for its intended purpose. In fact, the replacement of the switch taught by Harshberger with a screw in general would render Harshberger unsatisfactory for its intended purpose. In accordance with the Manual of Patent Examining Procedure (MPEP),

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed.Cir.1984)

MPEP §2143.01. In accordance with the teachings of Harshberger,

the primary object of this invention is to provide a novel computer system which lends itself to remote problem diagnosis and overnight parts exchange from supplier to user, the exchange parts then being quickly and easily installed by unskilled personnel so as to reduce cost and downtime to the user.

(Harshberger, col. 1, lines 39-44). Additionally, “[p]roviding the combination switch and lock assembly 172 eliminates plugging and unplugging CPU module 22 while powered up, thereby preventing damage to the internal logic of the unit and possible injury to the user.” The switch and lock assembly, then, helps to fulfill a primary object of the invention taught in Harshberger, i.e. “the exchange parts then being quickly and easily installed by unskilled personnel”

Replacing the switch with a screw would defeat this purpose.

Reply to Examiner's Response to Arguments

Applicant maintains, in accordance with the Amendment filed on December 4, 2002, that the Examiner has not pointed to any suggestion or motivation within the prior art to combine the references of Harshberger and Bolton in the manner described by the Examiner. Further, as is further discussed above, the combination of Harshberger and Bolton do not teach all the limitations of the claims. The Examiner, however, comments that

[i]n this case, the knowledge generally available to one of ordinary skill in the art suggests that applicant's claims are generally related to a simple latch mechanism having a screw as a pivoting element for the latch instead of a lock assembly, as disclosed in the prior art cited above, is well known and widely used in numerous domestic and industrial situations. In order to support examiner's position additional prior art disclosing several latching mechanisms using a screw as a pivoting element is cited in PTO 892 form attached to this office action.

(Final Office Action, p. 4).

The claimed inventions are not simply "related to a simple latch mechanism having a screw as a pivoting element for the latch instead of a lock assembly" as is suggested by the Examiner. Claim 1 recites "a rotation of said screw rotates said tab into position to clamp a portion of said panel between said tab and said flange" and has been amended for clarification to further recite "wherein further rotation of said screw forcibly clamps a portion of said panel between said tab and said flange." Claim 11 recites "rotating said screw to rotate said tab into position to clamp a portion of said panel between said tab and said flange" and has been amended for clarification to further recite "continuing rotation of said screw to forcibly clamp said portion of said panel between said tab and said flange."

As was discussed above, the combination of Harshberger and Bolton do not teach all of the elements of claims 1 and 11. Further, the art newly cited by the Examiner "disclosing several

latching mechanisms using a screw as a pivoting element” cited in the PTO 892, at best, teaches only the utilization of screws as pivots in latching mechanisms and do not cure the deficiencies in the teachings of Harshberger and Bolton.

CONCLUSION

Claims 1-18 are pending in the above identified application. Claims 1 and 11 have been amended in this Amendment. Claims 1-18, as is discussed above, are allowable over the cited art. Therefore, Applicant requests that the Examiner timely issue a Notice of Allowance for claims 1-18. If the Examiner contemplates a different action, the Examiner is invited to contact the Assignee’s attorney by phone at 650-849-6622 or by e-mail at gary.edwards@finnegan.com.

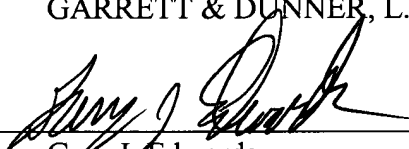
Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: March 24, 2003

By: _____


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APPENDIX A

MARKED-UP VERSION OF THE AMENDED CLAIMS

Claims 1 and 11 have been amended as indicated below:

1. (Amended) A panel mountable electronic device, said device comprising:

a housing including a flange through which passes a hole;

a tab having a threaded hole; and

a screw;

wherein said screw may be passed through said hole in said flange and engaged in said threaded hole such that a rotation of said screw rotates said tab into position to clamp a portion of said panel between said tab and said flange, and

wherein further rotation of said screw forcibly clamps a portion of said panel between said tab and said flange.

11. (Amended) A method of mounting an electronic device to a panel, said electronic device including a housing having a flange, said method comprising:

inserting a screw through a hole in said flange and into a threaded hole in a tab;

inserting a portion of said housing through an opening in said panel; [and]

rotating said screw to rotate said tab into position to clamp a portion of said panel between said tab and said flange; and

continuing rotation of said screw to forcibly clamp said portion of said panel between said tab and said flange.